

Application No.: 10/062,258

Docket No.: HO-P02314US1

**REMARKS**

Claims 1-4, 7-13, and 21-28 are pending. Claims 14-22 have been cancelled as they are drawn to a non-elected invention. Claims 2, 5 and 6 have been cancelled without prejudice and without acquiescence. Claims 1, 8-10 and 13 have been amended without prejudice and without acquiescence to clarify the scope of the invention. New claims 21-28 have been added. Support for the amendments and new claims can be found throughout the specification and originally filed, more specifically paragraphs [0035], [0065], [0076], [0078], [0081], and figure 1. Applicants retain the right to file a divisional application on any canceled material. Applicants assert that no new matter has been added.

The issues outstanding in this application are as follows:

- Claims 1 and 13 are rejected under 35 U.S.C. 112, second paragraph as being indefinite.
- Claims 1-13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Gordon (US 5,892,577).

Applicant respectfully traverses the outstanding objections and rejections, and applicant respectfully requests reconsideration and withdrawal thereof in light of the amendments and remarks contained herein.

I. 112 Rejections

Claims 1 and 13 are rejected under 35 U.S.C. 112, second paragraph as being indefinite. Applicants traverse.

The Examiner has rejected claim 1 as indefinite. Claim 1, as amended, cures the typographical error that led to the Examiner's confusion.

The Examiner has rejected claim 13 as indefinite. The term "flow conditions" is used in the Specification at ¶'s 91, and 105. "Flow conditions" clearly refers to the conditions under which samples are flowing through the microfluidic sample cavity where

25550033.2

5

Application No.: 10/062,258

Docket No.: HO-P02314US1

measurements are taken. [Specification at ¶ 91]. One of skill in the art of microfluidic sample analysis would have no trouble understanding this term. [See, e.g., Specification ¶ 4, 7 and 8].

However, in order to advance prosecution, Applicants have amended claim 13 without acquiescence and without prejudice to clarify the scope of the claim.

In view of the above arguments and amendments, Applicants respectfully request that the rejection be withdrawn.

## II. 102 Rejections

Claims 1-13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Gordon (US 5,892,577). Applicants traverse.

In order to advance the prosecution of the present invention, Claim 1 is amended without acquiescence and without prejudice to clarify that the microcavity is part of a microchannel structure in which aliquots of liquid can be transported and processed. Gordon does not teach this element nor is it necessarily present in the Gordon device. Hence, claim 1, as amended, is not anticipated by Gordon. Furthermore, by definition, claims 2-5, 7-11, and 13 directly or secondarily depend on amended claim 1 and are thus also not anticipated by Gordon.

Regarding claim 12, the Examiner has argued that Gordon discloses a black calibration mark on a disk and that claim 12 does not preclude non-black materials. (Examiner's Office Action of 06-15-2005, pg 4 ¶ 2) Claim 12 is limited to black disks. Gordon does not disclose a black disk nor is a black disc necessarily present in the Gordon device. In fact, a completely black disk would negate the black mark element of Gordon and render such an embodiment inoperative. Thus, claim 12 is not anticipated by Gordon.

In view of the above amendments and arguments, Applicants assert that Gordon does not teach each and every element of independent claim 1, nor the dependent claims. Thus, Applicants request that this rejection be withdrawn.

Application No.: 10/062,258

Docket No.: HO-P02314US1

**CONCLUSION**

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P02314US1 from which the undersigned is authorized to draw.

Dated: September 15, 2005

Respectfully submitted,

By 

Melissa W. Acosta, Ph.D.

Registration No.: 45,872

FULBRIGHT &amp; JAWORSKI L.L.P.

Fulbright Tower

1301 McKinney, Suite 5100

Houston, Texas 77010-3095

(713) 651-5151

(713) 651-5246 (Fax)

Agent for Applicant